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On 11/19/07  
(Date)

  
Julie H. Gamotis

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of  
OSTERGAARD et al.

Serial No.: 10/519,301

Art Unit: 2833

Filed: January 25, 2005

Examiner: Vit W. Miska

For: BLISTER LABEL

## RESPONSE

To the Director of Patents and Trademarks

Sir:

In response to the office action dated October 19, 2007, Applicant provisionally elects claims 1-12 in Group I and traverses the requirement for restriction.

The two independent claims 1 and 14 contain similar features in elements and steps and should be examined together. Claim 13, which depends from claim 1, is a linking claim which should be grouped with claim 1.

The inventions as described in the claims are neither independent nor distinct. In fact, the inventions as claimed arise from the same inventive effort. Where inventions are neither independent nor distinct, restrictions should not be required. Where inventions arise from the same inventive effort, restriction should not be required.

MPEP 802.01 points out that a sub-combination and a combination are not independent inventions, and that a process and an apparatus used in the practice of the process are not independent inventions. That same section points out that independent means that there is no disclosed relationship between the subjects disclosed.

The examiner has not made any requirement based on the subject matter being independent. Therefore it is understood that the examiner concedes that the subject matter is not independent.

The examiner's requirement for restriction is based upon his holding that the subjects are distinct. That is, as pointed out in Section 802.01, the examiner has held that the subject matter as claimed:

are capable of separate manufacture, use or sale as claimed,  
AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER.

The examiner has held under Section 803 that the claimed inventions:

are able to support separate patents and they are ...  
distinct (MPEP Section 806.05-806.05(i)).

However, Section 803 unequivocally states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

So that Section 803 makes its point clearly, the serious burden requirement is repeated under the title:

CRITERIA FOR RESTRICTION BETWEEN  
PATENTABLY DISTINCT INVENTIONS

Section 803 goes on to state that there are two criteria for a restriction requirement: one, that the inventions must be distinct as claimed; and two, that there must be a serious burden on the examiner if restriction were not required.

Section 803 goes on to state under GUIDELINES that an examiner must provide reasons and/or examples to support conclusions. The examiner has never stated that there would be a serious burden on the examiner if restriction were not required. Indeed, there should be no serious burden on the examiner. The examiner in this case is a senior examiner and is well skilled in examining the subject matter of claims 13-21.

No claim is drawn to another invention, and therefore it is believed that no difficult search is required.

The claims are all close together and are all within the subclasses which the examiner regularly searches, and all require searching and indeed are indented under each other in the classic outline form. Indeed, it would not be unreasonable for the examiner to search subclasses that were close together and indented. Therefore restriction should not be required.

With regard to the examiner's specific points, in the following paragraphs it can be seen that restriction is not proper.

Groups I and II inventions are not distinct. Claim 14, for example, is substantially similar to Claim 1. Both groups result from the single inventive effort. Claim 14, for example, sets forth the specifics of the sub-combination of as defined in

claims 1-12. The combination as claimed in claim 14 sets forth the details of the sub-combination. The two-way distinctiveness required by 806.05(c) cannot be established. The combination as claimed in claim 14 requires the sub-combination as claimed. There is no separate classification, status or field of search as required by 806.05(c) by the examiner for Groups I and II. All subclasses would have to be examined in both cases.

Invention II is related because they all require the structure of Group I claims, and they all use the process of Group II claims.

The inventions of Groups I and II are not different combinations in that they do not have "different modes of operation" as required by 806.04. Moreover, where inventions are related as disclosed but are not distinct as claimed, restriction is never proper (MPEP 806). The inventions are not distinct as claimed because each invention requires the low pressure gas releasing nose pieces as claimed. Moreover, there is no serious burden on the examiner.

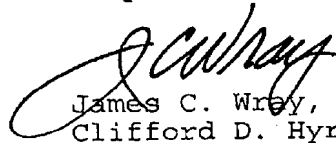
MPEP 806 provides that if the inventions are not distinct as claimed, restriction is never proper.

The process as claimed in Group II claims is not distinct from the products as claimed in the Group I claims. For example, the process as claimed in claim 14 (Group II) is not distinct from the product as claimed in claim 1 (Group I). Moreover, Section 806.05(h) emphasizes "as claimed" and falls under the cautions of 806 and 806.05, both of which state, "where the

inventions are related as disclosed but are not distinct as claimed, restriction is never proper". In the present case the particular criteria and guidelines of 803 must be followed in that there must be a serious burden on the examiner if restriction were not required. In the present case, all of the groups must be searched in all of the subclasses which the examiner has pointed out. All are properly classified and searched together, and the search for one group would not be complete without searching all.

Reconsideration and allowance of the application are requested. Reconsideration and withdrawal of the restriction requirement are requested.

Respectfully,



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November 19, 2007